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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/966,896 | 09/28/2001 | Travis J. Parry | 10012806-1 | 4357 |

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| EXAMINER |
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HANG, VU B

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| ART UNIT | PAPER NUMBER |
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2622

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,896

Applicant(s)

PARRY, TRAVIS J.

Examiner

Vu B. Hang

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/28/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,12, 15, 16, 18, 19, 20, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Canon Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4).

Regarding **Claim 1**, Canon discloses a method of sending a print job to a printer (see [0001], Line 7-14), comprising: attaching at least one document to an e-mail message (see [0003], Line 29-32), sending the e-mail message over a network to e-mail enabled printer (see [0001], Line 7-14), and extracting at least one document from the e-mail message by the e-mail enabled printer (see [0016], Line 28-37).

Regarding **Claim 12**, Canon discloses a document attached to an e-mail message is in an application-specific format (see [0017], Line 40-48 and [0052], Line 1-6).

Regarding **Claim 13**, Canon discloses a conversion of a document in an application-specific format into a print ready file (see [0021], Line 33-38).

Regarding **Claim 15**, Canon discloses a method for distributing a document for printing (see [0001]), comprising: attaching at least one document to an e-mail message (see [0003], Line 29-32), sending an e-mail message to an e-mail enabled print server of a local network (see [0009]), extracting the document at the e-mail enabled print

server (see [0016]), and sending the document to the network printer of the local network by the e-mail enabled server (see [0021, Line 33-35).

Regarding **Claim 16**, Canon discloses a method comprising converting a document into a print ready file by the e-mail enabled print server prior to sending the document to the network printer (see [0021]).

Regarding **Claim 18**, Canon discloses a method comprising printing at least one document by the network printer (see [0009]).

Regarding **Claim 19**, Canon discloses a system for receiving and distributing a remotely sent print job to a network printer (see Fig. 4), comprising: an e-mail enabled server device for communication with a network (Fig.4, (3104)), the e-mail enabled server configured for receiving an e-mail message having a document attached as a print job (see Fig.4, (3103) and [0009]), the e-mail enabled print server configured for extracting document from the e-mail message and for transmitting the document to at least one network printer device (see [0020]), and a network printer device configured to be communicatively coupled to the e-mail enabled print server device over the network (see Fig. 6), the network printer device for storing and for printing print jobs transmitted by the e-mail enabled print server device (see Fig.1 (108, 109) and [0053]).

Regarding **Claim 20**, Canon discloses a system wherein the e-mail enabled print server device includes at least one microprocessor configured for converting the document sent as print job into a print ready file (see Fig. 6 (2102)).

Regarding **Claim 21**, Canon discloses a computer system for processing print jobs (see Fig.1), comprising: an e-mail enabled device for creating and sending e-mail

with attachments (see Fig.1 (101, 102)), an e-mail enabled printer for receiving, extracting attachments from the e-mails, and printing the attachments (see Fig.1 (108, 109)), and a network for communicating emails between the e-mail enabled device and the e-mail enabled printer (see Fig.1 (103, 106)).

Regarding **Claim 24**, Canon discloses a computer system for processing print jobs (Fig.1), comprising: an e-mail enabled device for creating and sending e-mail with attachments (Fig.1 (101,102)), an e-mail enabled print server for receiving e-mails with attachments, extracting attachments from e-mails and sending attachments for printing (Fig.1 (105)), a network printer for receiving and printing attachments extracted from e-mails by the print server (Fig.1 (102,109)), and a network facilitating communications between the e-mail enabled device, the e-mail enabled server and the network printer (Fig.1 (103,106)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 4, 5, 6, 7, 9, 11, 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canon Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4).

Regarding **Claims 2, 5, 17 and 22**, Canon discloses storing print data in a print job object to be transferred to an adapter connected to a printer (see [0069, Line 46-50).

Cannon also discloses that a printer in the network can store information coming from the network server (see [0050], Line 27-31).

It is known in the art that printing devices contain high capacity storage area known as job retention. At the time of the invention, it would have been obvious for one skilled in the art to have attached documents be stored in the printer's job retention. The motivation for doing so would be to enable a workstation user to print the same documents at later time without repeating the e-mail transfer and retrieve process.

Regarding **Claims 3 and 4**, as mention in the 103(a) rejection of Claim 2 above, Canon discloses storing print data in a print job object to be transferred to an adapter connected to a printer (see [0069, Line 46-50) and that a printer in the network can store information coming from the network server (see [0050], Line 27-31).

As mention the 103(a) rejection of Claim 2 above, it is known in the art that a printer usually contains a job retention area. At the time of the invention it would have been obvious for one skilled in the art to have an e-mail enabled printer to specify instructions for storing and reading data to its job retention area. It is obvious that in order to store data in the printer, the printer must specify its own instructions for storing and reading the incoming data.

Regarding **Claim 5**, Canon as mention in the 103(a) rejection of Claim 2 above, Canon discloses storing print data in a print job object to be transferred to an adapter connected to a printer (see [0069, Line 46-50). Canon also discloses that the printer prints data converted by and sent from the adapter (see [0009], Line 22-23).

As mention the 103(a) rejection of Claim 2 above, it is known in the art that a printer usually contains a job retention area. At the time of the invention, it would have been obvious for one skilled in the art to have the e-mail enabled printer store a document to be printed in its job retention in conjunction to printing the document. The motivation for doing so would be to keep the printer data stored at the remote printer for later use. This can allow the user to avoid resending the data to that particular remote printer.

Regarding **Claim 6**, Canon discloses instructions for performing document prints (see [0019]).

At the time of the invention, it would have been obvious for one skilled in the art to have the method of Claim 1 specify instructions for printing the attached document. Such instructions are necessary when performing print processes for any network printing system.

Regarding **Claim 7**, Canon discloses that the network print server providing a means for specifying printing attributes (see [0107] and [0108]).

At the time of the invention, it would have been obvious for skilled in the art to have the method of Claim 1 to specify printing attributes when specifying printing instructions. Specifying the print attributes is part of the instructions for printing data (i.e. part of a print job).

Regarding **Claim 9**, Canon discloses a printer readable program that contains instructions for printing (see [0019]), as mentioned in the 103(a) rejection of Claim 6 above.

At the time of the invention it would have been obvious for one skilled in the art to provide instructions via e-mail that is printer readable since the instructions will be stored in the job retention of the printer. The printer, therefore, must interpret the instructions to perform the printing in a network environment. Otherwise, the printer can only print based on instructions manually inputted by a user.

Regarding **Claim 11**, Canon discloses encoding the printer readable language in MIME encoding field (see [0052], Line 6-10).

At the time of the invention, it would have been obvious for one skilled in the art to use the MIME encoding field to encode the printer readable language. It is necessary for the receiving printer or the controlling software of the receiving printer to understand what the data received from the e-mail message represents. It is necessary to use the MIME encoding field since it tells what is in the e-mail message so that the contents can be used in an appropriate way.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canon Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Fabbio et al. (US Patent 5,870,089).

Regarding **Claim 8**, Canon discloses specifying instructions for documents prints as mentioned in Claim 6 but fails to disclose expressly scheduling the print instructions. Fabbio, however, discloses a means to schedule the transferring of data packages from a storage queue to destination devices (i.e. printer, fax) in a network (see Fig. 5 (118) and Col.8, Line 10-37).

Canon and Fabbio are combinable because they are from the same field of endeavor, namely network printing apparatus. At the time of the invention it would have been obvious for one skilled in the art to incorporate the use of a scheduling process to prioritize or schedule the print process. The motivation for doing so would be to have a set process of determining the priority of the documents to be printed. Since many documents could be stored to the job retention of the printer, it would be useful to prioritize documents and have them print in specific orders.

Claims 10, 14 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canon Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Harkins et al. (US Patent 5,689,642).

Regarding **Claims 10 and 23**, Canon discloses specifying instructions for documents prints as mentioned in Claim 6 but fails to disclose expressly a method to encode the printable readable language prior to sending the e-mail message over the network. Harkins, however, discloses encoding printer readable language prior to transmitting the data over the network (see Col. 11, Line 28-41).

Canon and Harkins are combinable because they are from the same field of endeavor, namely network printing apparatus. At the time of the invention, it would have been obvious for one skilled in the art to incorporate a method to encode the printer readable language to the method described in Claim 6 above. The motivation for doing so would be to create a more productive printing process by eliminating the need to convert from multiple sender formats to the desired printer format by the printer.

Regarding **Claim 14**, Canon discloses the method as described in Claim 1 above but fails to expressly disclose that the attached document to the e-mail message is in bit-mapped format. Harkins, however, discloses bit-mapped files are being sent to the printer over the network (see Col.2, Line 34-44).

Canon and Harkins are combinable because they are from the same field of endeavor, namely network printing apparatus. At the time of the invention, it would have been obvious for one skilled in the art to have the document attached to the e-mail message in bit-mapped format for the method described in Claim 1 above. The motivation for doing so would be to create a more productive printing process. Having the documents be converted to this format prior to being received at the printer would speed the process of printing. With many documents/data to be printed stored in the queue, it would be time consuming to have the conversion process done for each document at the printer.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571)272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vu Hang
Assistant Examiner



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